In the Claims

Applicants request entering the below amendments to the claims. Claim 6, 7, 18, 21, 25, 30, 34 is amended. For the PTO's convenience, claims that remain unchanged are included below in order to allow the Examiner to review all pending claims from this response in their numerical order.

3.   A method of delivering a receiver specific program at a receiver station having a computer and one or more output devices, said method comprising the steps of:

receiving a broadcast or cablecast information transmission comprising one or more units of programming and one or more control signals;

selecting said received one or more units of programming from the information transmission and transferring each of said selected one or more units of programming to one or more of:

(1)   said computer for processing; and

(2)   a first of said output devices for delivery to a user;

detecting said one or more control signals in said broadcast or cablecast information transmission and passing said detected one or more control signals to said computer; and

controlling said computer based on said one or more control signals, said step of controlling comprising:

(1)   generating a receiver specific value by processing information that is stored in said computer;

(2)   generating a receiver specific signal based on said receiver specific computer generated value; and

(3)   communicating a unit of programming to said output device based on said generated receiver specific signal; and

delivering said receiver specific program at said one or more output devices, said

receiver specific program including a simultaneous or sequential presentation of two or more of

units of programming, said two or more units of programming including said communicated unit

of programming and at least one of said received and selected one or more units of programming.

4.   The method of claim 3, further comprising the steps of:

communicating said generated receiver specific signal to a selective transmission device;

and

controlling said selective transmission device to select said received one or more units of

programming.

5.   The method of claim 3, wherein said generated receiver specific signal is a

programming signal, said method further comprising the step of placing one or more data for

output at a memory location that outputs to said output device.

6.   (Twice Amended) A method of delivering a receiver specific program at at least one

of a plurality of receiver stations, each of said plurality of receiver stations having a computer

and an output device, comprising the steps of:

receiving a first control signal at one or more origination transmitters;

receiving a second control signal at said one or more origination transmitters, said

second control signal operative to communicate said first control signal to an intermediate

transmitter; and

transmitting said first control signal to said at least one of said plurality of receiver

stations, said first control signal effective at said at least one of a plurality of receiver stations to

control said computer to compute a receiver specific value by processing information stored in

said computer, [compute]generate a receiver specific signal based on said receiver specific value,

and communicate a unit of programming to said output device based on said receiver specific signal.

7. (Twice Amended) A method of delivering a receiver specific program at at least one of a plurality of receiver stations, each of said plurality of receiver stations having a computer and an output device, comprising the steps of:

receiving and storing a control signal at a transmitter station; and

causing said control signal to be communicated to a transmitter at a specific time, thereby to transmit said control signal, said control signal effective at said at least one of a plurality of receiver stations to control said computer to compute a receiver specific value by processing information stored in said computer, [compute]generate a receiver specific signal based on said receiver specific value, and communicate a unit of programming to said output device based on said receiver specific signal.

8. The method of claim 3, wherein said receiver specific program is a computer program, said received one or more units of programming comprise some of a software module, and said one or more control signals operate to generate at least some of the balance of said software module, said method further comprising the step of incorporating said generated receiver specific value into code.

9. The method of claim 3, wherein said received one or more units of programming comprise some of at least one complete image and said communicated unit of programming includes the balance of said at least one complete image, said method further comprising the steps of:

synchronizing the delivery at or communication from said output device of said delivered two or more units of programming based on information contained in said one or more control signals; and

producing said balance of said at least one complete image at a specific image location.

10. The method of claim 3, further having one step from the group consisting of:

assembling at least some portion of said one or more control signals;

compiling code to be communicated in said generated receiver specific signal;

linking a unit of programming to be communicated to one of said computer and said output device; and

processing machine language code containing said generated receiver specific value.

11. The method of claim 3, further including the step of storing at least one of said received one or more units of programming for subsequent selection and communication to said output device.

12. The method of claim 3, wherein said output device is a memory, said method further including the step of:

communicating said receiver specific value from said memory to one of the group consisting of:

     (1)   a video monitor;

     (2)   a speaker;

     (3)   a printer;

     (4)   a processor;

     (5)   a signal generator; and

     (6)   a transmitter.

13. The method of claim 3, wherein said information that is stored in said computer in inputted by said user in response to said receiver specific program, said method further comprising the step of:

transferring at least some of said received and selected one or more units of programming to said output device before generating said receiver specific value.

14.   The method of claim 3, further comprising the steps of:

generating said receiver specific value based on a schedule; and

selecting at least a portion of said received broadcast or cablecast information transmission in response to said generated receiver specific signal.

15.   The method of claim 3, wherein said received information transmission contains a code portion, at least some of said one or more units of programming and said one or more control signals is contained in said code portion, and said receiver station has a portion receiver, said method further comprising the step of:

controlling said portion receiver to be capable of receiving and transferring expanded or contracted code portion information transmissions.

16.   The method of claim 3, further comprising the step of clearing a specific memory location in response to said one or more control signals.

17.   The method of claim 3 wherein the step of generating said receiver specific value by processing information that is stored in said computer is achieved by executing a computer program stored in the memory of said computer to process said stored information, and said method includes one step from the group consisting of:

loading said computer program into the memory of said computer in response to said one or more control signals;

detecting said computer program in said information transmission; and

fetching a software module from a memory peripheral in response to said one or more control signals.

18. (Twice Amended) The method of claim 3 wherein the processing, generating, and/or outputting of said computer is controlled by a programmable controller in response to control signals detected in the broadcast or cablecast information transmission, said method having one step from the group consisting of:

interrupting said controller to cause said computer one of to generate and communicate said communicated unit of programming at a specific time;

instructing said controller to cause said computer to communicate a specific receiver specific datum to said output device;

programming said controller to interrupt a specific one of a plurality of processor and/or controller devices; and

detecting a interrupt signal in the information transmission and controlling said controller to communicate said detected interrupt signal to a processor or controller.

19. The method of claim 18, further comprising the steps of detecting a control program in the information transmission and causing said controller to control one or more receiver station devices in accordance with said control program.

20. The method of claim 3, further comprising the steps of:

identifying at least a first of said one or more control signals;

storing information confirming a passing of said identified first control signal;

effecting a comparison between said stored information and an identifier so as to generate a control signal; and

controlling said receiver station in accordance with said control signal.

21. (Twice Amended) The method of claim 6, wherein said computer is operatively connected to said intermediate transmitter for generating some portion of one of a computer

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program and a data module in response to an instruct signal, said method further comprising the

steps of receiving said instruct signal at said <u>one or more</u> origination transmitters and

transmitting said instruct signal to said computer.

22.   The method of claim 6, wherein said receiver specific program includes a

simultaneous or sequential presentation of two or more of units of programming, said method

further comprising the steps of:

receiving said at least one of said two or more units of programming and communicating

said at least one of said two or more units of programming to said one of said one or more

origination transmitters and said intermediate transmitter.

23.   The method of claim 3, wherein said receiver specific value is a financial value.

24.   The method of claim 23, further comprising the steps of:

processing financial data stored at said receiver station; and

identifying programming to be selected based on said step of processing financial data.

25.   (Twice Amended) A method for controlling the transmission of a control signal from

an intermediate transmitter station to a receiver station, said intermediate transmitter station

having a <u>first</u> computer, one or more receivers and one or more transmitters, comprising the steps

of:

receiving, at one or more of said receivers of said intermediate transmitter station,

one or more first control signals, each of said <u>one or more</u> first control signals received from

outside of said intermediate transmitter station;

receiving, at one or more of said receivers of said intermediate transmitter station,

one or more second control signals, each of said second control signals received from outside of

said intermediate transmitter station, [and operable] <u>wherein said one or more second control</u>

signals are operative to cause said <u>first</u> computer in said intermediate transmitter station to select a specific first control signal and to communicate said selected first control signal to at least one of said transmitters of said intermediate transmitter station; and

transmitting, from said one or more transmitters of said intermediate transmitter station to said receiver station, said selected first control signal, said selected first control signal [operable]<u>operative</u> at said receiver station to control a second computer to generate a receiver specific value by processing information stored in said second computer, generate a receiver specific signal based on said receiver specific value, and communicate a unit of programming to an output device based on said receiver specific signal.

26.   The method of claim 25, wherein each of said one or more first control signals is received at said intermediate transmitter station before each of said one or more second control signals is received.

27.   The method of claim 25, wherein at least one of said one or more first control signals is received at said intermediate transmitter station after one or more of said second control signals is received.

28.   The method of claim 25, further comprising the step of storing said selected first control signal at one or more storage devices contained within said intermediate transmitter station.

29.   The method of claim 28, wherein the time of said transmitting step is performed according to information contained within said one or more second control signals.

30. (Twice Amended) A method for controlling the transmission of a control signal from an intermediate transmitter station to a receiver station, said intermediate transmitter station

having a computer, one or more storage devices, one or more receivers and one or more transmitters, said method comprising the steps of:

receiving, at one or more of said receivers of said intermediate transmitter station, one or more first control signals, each of said first control signals received from outside of said intermediate transmitter station;

storing said one or more received first control signals in one or more of said storage devices;

selecting one or more of said received first control signals to be communicated to one or more of said transmitters of said intermediate transmitter station; and

transmitting, from said one or more transmitters of said intermediate transmitter station to said receiver station, one or more of said selected one or more first control signals, each of said selected one or more first control signals [operable]operative at said receiver station to control a second computer to generate a receiver specific value by processing information stored in said second computer, generate a receiver specific signal based on said receiver specific value, and communicate a unit of programming to an output device based on said receiver specific signal.

31.	The method of claim 30, further comprising the step of receiving one or more second control signals, wherein said selecting step is performed by said computer based on information contained within said one or more second control signals.

32.	The method of claim 31, wherein said transmitting step is performed based on information contained within said one or more second control signals.

33.	The method of claim 6, further comprising the steps of:

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receiving operating instructions at said one or more origination transmitters, said operating instructions effective to control a processor to respond to one of said first control signal and said second control signal; and

transmitting said operating instructions to one of said intermediate transmitter station and said plurality of receiver stations.

34. (Amended) The method of claim 7, further comprising the steps of:

receiving operating instructions at said one or more transmitter station, said operating instructions effective to control a processor to respond to <u>said</u> control signal; and

transmitting said operating instructions to at least one of said plurality of receiver stations.

II.   REMARKS

A.   Introduction

The Office Action dated January 26, 1998 (Office Action) has been carefully reviewed and the foregoing amendments made in response thereto.

Claims 6, 7, 18, 21, 25, 30, 34 are amended. Claims 3-34 are pending in the application.

Claims 3-34 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 3-34 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 21 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claim 6 is rejected under 35 U.S.C. § 102 (b) as being anticipated by Metz et al., U.S. Patent No. 3,648,270.

Claims 6, 7 and 22 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Epstein, U.S. Patent No. 3,387,268 in view of Linstroth et al., U.S. Patent No. 4,942,616 or Toy, U.S. Patent No. 4,554,418.

Claims 33 and 34 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Epstein, U.S. Patent No. 3,387,268 in view of Linstroth et al., U.S. Patent No. 4,942,616 or Toy, U.S. Patent No. 4,554,418 further in view of Fletcher et al., U.S. Patent No. 4,054,911.

Claims 6 and 7 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Foss, U.S. Patent No. 1,927,702 in view of Fletcher et al., U.S. Patent No. 4,054,911.

Claims 25-32 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over "TELESOFTWARE – VALUE ADDED TELETEXT" by J. Hedger et al. (hereinafter "Hedger") in view of Cox et al., U.S. Patent No. 4,388,645.

Claims 25-32 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Fletcher et al., U.S. Patent No.4,054,911 in view of Linstroth et al., U.S. Patent No. 4,942,616 or Toy, U.S. Patent No. 4,554,418 further in view of Cox et al., U.S. Patent No. 4,388,645.

Independent claim 3 and dependent claims 4-5, 8-20 and 23-24 are not indicated as being rejected over any prior art of record and Applicants assume that it is allowable but for the rejection under 35 U.S.C. § 112.

Claims 3-34 remain active in this application. No new matter is presented in the foregoing amendments. Approval and entry of same is respectfully requested.

B. Response to Requirement Imposed Upon Applicants to Resolve Alleged Conflicts Between Applicants' Applications.

Applicants respectfully traverse the requirements of the Office Action paragraph 6.

Paragraph 6 of the Office Action requires Applicants to either:

(1)   file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications; or

(2)   provide an affidavit attesting to the fact that all claims in the 328 applications have been reviewed by applicant and that no conflicting claims exist between the applications; or

(3)   resolve all conflicts between claims in the related 328 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 328 applications.

In addition, Examiner states that failure to comply with any one of these requirements will result in abandonment of the application.

Examiner states that the requirement has been made because conflicts exist between claims of the related co-pending applications, including the present application. Examiner sets forth only the serial numbers of the co-pending applications without an indication of which claims are conflicting. Examiner has also attached an Appendix providing what is deemed to be clear evidence that conflicting claims exist between the 328 related co-pending applications and the present application. Further, Examiner states that an analysis of all claims in the 328 related co-pending applications would be an extreme burden on the Office requiring millions of claim comparisons.

Applicants respectfully traverse these requirements in that Examiner has both improperly imposed the requirements, and has incorrectly indicated that abandonment will occur upon failure to comply with the requirement. Applicants' traversal is supported by the fact that 37 C.F.R. § 1.78 (b) does not, under the present circumstances, provide Examiner with authority to require Applicants to either: 1) file terminal disclaimers; 2) file an affidavit; or 3) resolve all apparent conflicts. Additionally, the penalty of abandonment of the instant application for failure to comply with the aforementioned requirement is improper for being outside the legitimate authority to impose abandonment upon an application. The following remarks in Section (B) will explain Applicants' basis for this traversal.

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1.   **The PTO's New Requirement is an Unlawfully Promulgated Substantive Rule Outside the Commissioner's Statutory Grant of Power**

The PTO Commissioner obtains his statutory rulemaking authority from the Congress through the provisions of Title 35 of the United States Code. The broadest grant of rulemaking authority -- 35 U.S.C. § 6 (a) -- permits the Commissioner to promulgate regulations directed only to "the conduct of proceedings in the [PTO]". This provision does <u>NOT</u> grant the Commissioner authority to issue substantive rules of patent law. <u>Animal Legal Defense Fund v. Quigg</u>, 932 F.2d 920, 930, 18 USPQ2d 1677, 1686 (Fed. Cir. 1991).[1] Applicants respectfully submit that the Examiner's creation of a new set of requirements based upon 37 CFR § 1.78(b) constitutes an unlawful promulgation of a substantive rule in direct contradiction of a long-established statutory and regulatory scheme.

2.   **The PTO's Requirement is a Substantive Rule**

The first determination is whether the requirement as imposed by the PTO upon Applicants is substantive or a procedural rule. The Administrative Procedure Act offers general guidelines under which all administrative agencies must operate. A fundamental premise of administrative law is that administrative agencies must act solely within their statutory grant of power. *Chevron v. Natural Resources Defense Council*, 467 U.S. 837 (1984). The PTO Commissioner has NOT been granted power to promulgate substantive rules of patent law. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996), citing, *Animal Legal Defense Fund v. Quigg*, 932 F.2d 920, 930, 18 USPQ2d 1677, 1686 (Fed. Cir. 1991).

The appropriate test for such a determination is an assessment of the rule's impact on the Applicants' rights and interests under the patent laws. *Fressola v. Manbeck*, 36 USPQ2d 1211, 1215 (D.D.C. 1995). As the PTO Commissioner has no power to promulgate substantive rules,

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[1] Accord <u>Hoechst Aktiengesellschaft v. Quigg</u>, 917 F.2d 522, 526, 16 USPQ2d 1549, 1552 (Fed. Cir. 1990); <u>Glaxo Operations UK Ltd. v. Quigg</u>, 894 F.2d 392, 398-99, 13 USPQ2d 1628, 1632-33 (Fed. Cir. 1990); <u>Ethicon Inc. v. Quigg</u>, 849 F.2d 1422, 1425, 7 USPQ2d 1152, 1154 (Fed. Cir 1988).

the Commissioner receives no deference in his interpretation of the statutes and laws that give

rise to the instant requirement. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996),

citing, *Chevron v. Natural Resources Defense Council*, 467 U.S. 837 (1984). <u>When agency rules

either (a) depart from existing practice or (b) impact the substantive rights and interests of the

effected party, the rule must be considered substantive.</u> *Nat'l Ass'n of Home Health Agencies v.

Scheiker*, 690 F.2d 932, 949 (D.C. Cir. 1982), *cert. denied*, 459 U.S. 1205 (1983).

> a. **The PTO Requirement is Substantive Because it
> Radically Changes Long Existing Patent Practice
> by Creating a New Requirement Upon
> Applicants Outside the Scope of 37 C.F.R. § 1.78
> (b)**

The Examiner's requirement is totally distinguishable from the well articulated

requirement authorized by 37 CFR § 1.78 (b), because it (1) creates and imposes a new

requirement to avoid abandonment of the application based on the allegation that conflicts exist

between claims of the related 328 co-pending applications, and (2) it results in an effective final

double patenting rejection without the PTO's affirmative double patenting rejection of the

claims. Long existing patent practice recognizes only two types of double patenting, double

patenting based on 35 U.S.C. § 101 (statutory double patenting) and double patenting analogous

to 35 U.S.C. § 103 (the well-known obviousness type double patenting).[2] These two well

established types of double patenting use an objective standard to determine when they are

appropriate[3] and have a determinable result on the allowability of the pending claims.

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[2]MPEP § 804(B)(1) states, in an admittedly awkward fashion, that the inquiry for obviousness type double patenting is analogous to a rejection under 35 U.S.C. 103: "since the analysis employed in an obvious-type double patenting determination parallels the guidelines for a 35 U.S.C. 103 rejection, the factual inquires set forth in <u>Graham v. John Deere Co.</u>, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis".

[3] The objective test for same invention double patenting is whether one of the claims being compared could be literally infringed without literally infringing the other. The objective test for obviousness type double patenting is the same as the objective nonobviousness requirement of patentability with the difference that the disclosure of the first patent may not be used as prior art.

The Examiner's new requirement represents a radical departure from long existing patent practice relevant to conflicting claims between co-pending applications of the same inventive entity. Two well established double patenting standards are based on an objective analysis of comparing pending and *allowed* claims. However, in the present application, there are no *allowed* claims. The Examiner's new requirement to avoid a double patenting rejection presumes that conflicts exist between claims in the present application and claims in the 327 copending applications. This presumption of conflicts between claims represents a radical departure from long existing patent practice as defined by 37 C.F.R. § 1.78 (b), which states:

> Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Clearly, the only requirement authorized by the rule is the elimination of conflicting claims from all but one application where conflicting claims have been determined to exist. Furthermore, in order to determine that conflicting claims do in fact exist in multiple applications, the only possible analysis is obviousness-type double patenting, since there are no allowed or issued claims by which to employ the 35 U.S.C. § 101 statutory double patenting analysis. Once obviousness-type double patenting analysis has been applied and conflicting claims have been determined to exist, only a *provisional* obviousness-type double patenting rejection is possible until claims from one application are allowed.

In summary, the Examiner's new requirement departs from long-established practice because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 328 co-pending applications, and (2) it results in an effective final double patenting rejection without the PTO's affirmative double patenting rejection of the claims.

Therefore, the Examiner's new requirement departs from existing practice and therefore is a **substantive rule** beyond the authority of the PTO and is therefore, invalid.

b. **The New Requirement is Also a Substantive Rule Because it Adversely Impacts the Rights and Interests of Applicants to Benefits of the Patent**

The rights and benefits of a U.S. patent is solely a statutory right. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996). The essential statutory right in a patent is the right to exclude others from making, using and selling the claimed invention during the term of the patent. Courts have recognized that sometimes new procedural rules of the PTO are actually substantive rules, e.g. when the new rule made a substantive difference in the ability of the applicant to claim his discovery. *Fressola v. Manbeck*, 36 USPQ2d 1211, 1214 (D.D.C. 1995) (emphasis added), citing, *In re Pilkington*, 411 F.2d 1345, 1349; 162 USPQ 145 (CCPA 1969); and *In re Steppan*, 394 F.2d 1013, 1019; 156 USPQ 143 (CCPA 1967).

The new requirement, on its face and as applied here, is an instance of a PTO rule making a substantive difference in Applicants' ability to claim their invention and, therefore, must be considered a substantive rule. The requirement denies Applicants rights and benefits expressly conferred by the patent statute. The measure of the value of these denied rights and benefits is that the requirement, as applied here, would deny Applicants the full and complete PTO examination of Applicants' claims on their merits, as specified by 37 C.F.R. § 1.105. In addition, to file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications based on the PTO's incomplete examination on the merits would deny Applicants the benefit of the full patent term of 17 years on each of Applicants' respective applications. Applicants respectfully submit that the requirement has a huge impact on their rights and interests in the presently claimed invention.

c. **Conclusion: Substantive Rule**

In summary, the requirement is a change to long existing practice and/or has a substantive impact on the rights and interests of Applicants to their invention. Either finding means that the new requirement is a substantive rule. Since the Commissioner has no power to issue

substantive rules, the requirement is an improperly promulgated substantive rule having no force of law.

3. The PTO Requirement is Outside the Scope of 37 C.F.R. § 1.78 (b)

Rule 78 (b) states that:

> Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

The only **requirement** that Rule 78 (b) authorizes is the elimination of conflicting claims from all but one co-pending applications.

In the instant Office Action, Examiner has not required the elimination of all conflicting claims from all but one application, but instead has required Applicants to: 1) file terminal disclaimers in each of the related 328 applications; 2) provide an affidavit; or 3) resolve all conflicts between claims in the related 328 applications. None of the options in the requirement is authorized by Rule 78 (b), and therefore Applicants respectfully submit that such a requirement is improper.

With respect to the PTO's authority to act within Rule 78 (b) regarding the rejection of conflicting claims, MPEP § 822.01 states that:

> Under 37 CFR § 1.78 (b), the practice relative to overlapping claims in applications copending before the examiner..., is as follows: Where claims in one application are unpatentable over claims of another application of the same inventive entity because they recite the same invention, *a complete examination should be made of the claims of each application* and all appropriate rejections should be entered in each application, including rejections based upon prior art. *The claims of each application may also be rejected on the grounds of provisional double patenting on the claims of the other application* whether or not any claims avoid the prior art. Where appropriate, the same prior art may be relied upon in each of the applications. MPEP 822.01 (6th Ed., Rev. 3, 1997), (*emphasis added*).

In light of the requirement of the Office Action, MPEP § 822.01 and 37 CFR § 1.78 (b) are not applicable since there has not been any rejection with regard to the elimination of conflicting claims from all but one co-pending application.

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4. **The Assertion That Failure to Comply with the Requirement Will Result in Abandonment of Applicants' Application is Improper**

Applicants' prospective failure to comply with the above requirements cannot properly result in abandonment of the present application. Applicants respectfully submit that abandonment of an application can properly occur only:

(1)   for failure to respond within a provided time period (under Rule 135);

(2)   as an express abandonment (under Rule 138); or

(3)   the result of failing to timely pay the issue fee (under Rule 316).

There is no provision in the rules permitting abandonment for failure to comply with any of the presented requirements. To impose an improper requirement upon Applicants and then hold the application is to be abandoned for failure to comply with the improper requirement violates the rules of practice before the USPTO. Furthermore, Examiner is in effect attempting to create a substantive rule which is above and beyond the rulemaking authority of the USPTO, and therefore is invalid.

In the *Application of Mott,* 539 F.2d 1291, 190 USPQ 536 (CCPA 1976), the applicant had conflicting claims in multiple applications. The CCPA held that action by the Examiner which would result in automatic abandonment of the application was legally untenable. *Id.* at 1296, 190 USPQ at 541. In the present application, Examiner has asserted that there are conflicting claims in multiple applications, and that non-compliance of the Office Action's requirement will result in an automatic abandonment. Therefore, under *Mott's* analysis, the Office Action's result of abandonment of Applicants' application is legally untenable.

5. **Response to Apparent Conflict of Claims**

Applicants submit that the presentation of the Office Action Appendix fails to demonstrate any conflicts between claims of the present application and claims of the co-pending applications. Rather, the Office Action Appendix compares representative claims of *other* applications in attempt to establish that "conflicting claims exist between the 328 related co-

pending applications." Absent any evidence of conflicting claims between the Applicants'

present application and any other of Applicants' co-pending applications, any requirement

imposed upon Applicants to resolve such alleged conflicts is improper.

6.   Request for Withdrawal of Requirement

Therefore, Applicants respectfully request that Examiner reconsider and withdraw the

requirement that Applicants: (1) file terminal disclaimers in each of the related 328 applications

terminally disclaiming each of the other 327 applications; (2) provide an affidavit attesting to the

fact that all claims in the 328 applications have been reviewed by applicant and that no

conflicting claims exist between the applications; or (3) resolve all conflicts between claims in

the above identified 328 applications by identifying how all the claims in the instant application

are distinct and separate inventions from all the claims in the above identified 328 applications,

which upon failing to do so will abandon the application.

7.   Filing of Supplemental Oath

Notwithstanding the foregoing, Applicants will file a supplemental oath under 37 C.F.R.

§ 1.67 for each application when Examiner identifies allowable subject matter. Applicants

respectfully propose that the filing of individual supplemental oaths attesting to the absence of

claim conflicts between previously patented claims and subsequently allowed claims is a more

reasonable method of ensuring the patentable distinctness of subsequently allowed claims.

Under 37 C.F.R. § 1.105, § 1.106 & § 1.78 (b), Examiner has the duty to make every

applicable rejection, including double patenting rejection. Failure to make every proper rejection

denies Applicants all rights and benefits related thereto, e.g., Applicants' right to appeal, etc.

Once obviousness-type double patenting analysis has been applied and conflicting claims have

been determined to exist, only a *provisional* obviousness-type double patenting rejection is

possible until claims from one application are allowed.

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C.   Information Disclosure Statement

The Applicants appreciate the Examiner's review of the Information Disclosure

Statements filed 12/11/95, 12/22/95, 2/6/96, 4/17/96, and 4/7/97 and have addressed those

specific concerns raised in paragraph 7 of the Office Action. It is the Applicants' understanding

that the Examiner raised the following 5 issues:

(1)   the reasons for such a large number of references cited,

(2)   foreign language references cited without a statement of relevance or translation

have not been considered,

(3)   the relevancy of numerous references listed in the Information Disclosure

Statements are subsequent to the Applicants' latest effective filing date of 9/11/87,

(4)   citation of references apparently unrelated to the subject matter of the claimed

invention, and

(5)   citation of database search results listed in foreign languages where no copy was

provided.

1.   Reason for Citation of Large Number of References

The reason that the Applicants submitted such a large number of references in the

Information Disclosure Statements was that a large portion of the information cited by the

Applicants was brought to the Applicants' attention in the discovery processes in a previous

litigation in the United States District Court for the Eastern District of Virginia (*Personalized*

Mass Media Corp. v. The Weather Channel, Inc. Docket No. 2:95 cv 242) and an investigation

by the International Trade Commission (*In the Matter of Certain Digital Satellite System (DSS)*

Receivers And Components Thereof, No. 337 TA 392, which was direct to U.S. Pat. No.

5,335,277) regarding claims in the Applicants' related issued patents. The documents listed in

the Information Disclosure Statement were cited during the previous litigation/investigative

proceedings by the alleged infringers in the aforementioned proceedings as being relevant and

material to patentability of the claims in the related patents. The Applicants submitted those

materials in the Information Disclosure Statement to the PTO at the earliest possible time in

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order to file them in compliance with the 3 month requirement stated in the certification used to

submit the Information Disclosure Statement before the Office Action was issued as is necessary

under 37 CFR § 1.97 (c) (1). In such haste, entries were inadvertently submitted which do not

appear on their face to be material to the patentability of the present application. Applicants

have corrected this error with the submission of the corrected Information Disclosure Statement

as shown in Appendix B. However, it is the Applicants' understanding that not all references

cited must be material to patentability in order for such references to be considered. In § 609 of

the MPEP, it states,

> "[t]hese individuals also may want the Office to consider information for a variety
> of reasons: e.g., without first determining whether the information meets any
> particular standard of materiality, or because another patent office considered the
> information to be relevant in a counterpart or related patent application filed in
> another country, or to make sure that the examiner has an opportunity to consider
> the same information that was considered by the individuals that were
> substantially involved in the preparation or prosecution of a patent application."

Applicants' position is that information that was considered material in previous litigation

would fall into the 'variety of reasons' category as stated above. Applicants intention was not to

confuse or make difficult the examination process for the Examiner, but was instead to be

forthright and open in disclosing all information deemed to be relevant to the application in issue

by third parties.

2. Citations of Foreign Language References

Applicants have re-examined the foreign references listed in all of the Information

Disclosure Statements and have either eliminated such references from the list, included

translations herewith or provided statements as to the relevancy of such references (APPENDIX

A). The inclusion of translations with this response is in compliance with 37 C.F.R. § 1.97 (f)

which states in part, "[I]f a bona fide attempt is made to comply with 37 C.F.R. § 1.98, but part

of the required content is inadvertently omitted, additional time may be given to enable full

compliance." The omission of any translations and/or relevancy statements for foreign

references were inadvertent and unintentional and are herein submitted in accordance with 37

C.F.R. § 1.97 (f).

3. References in the Information Disclosure Statements Subsequent to Applicants' Latest Effective Filing Date of 9/11/87

Examiner stated "[n]umerous references listed in the IDS are subsequent to the

applicant's latest effective filing date of 9/11/87, therefore, the relevancy of those references is

unclear." Upon further examination, the Applicants have eliminated those patents and

publications after the effective filing date for the present application. It is the Applicants'

understanding that the effective filing date for the present application is 9/11/87.

4. Citation of Unrelated References

Applicants appreciate the Examiner pointing out such references that were listed yet on

their face appear to be unrelated to the subject matter of the present application. In response to

such information, the Applicants have reviewed the cited references and removed any such

references which appear to be unrelated on their face to the claimed subject matter such as the

patent for a beehive, the patent for a chemical compound and numerous computer printout search

results.

5. Citation of Database Search Results

Database search results listed in foreign languages where no copy was provided have

been eliminated from the substitute Information Disclosure Statement included with this office

action.

The Applicants offer the corrected Information Disclosure Statement (APPENDIX B) as

a substitute to the previously filed Information Disclosure Statement filed 4/7/97. No new entries

have been entered, only citations which have, upon further examination, been determined not to

be relevant to the claimed subject matter have been eliminated, typographical errors have been

corrected, dates inserted where possible and the list shortened as a result. It is the Applicants'

intention that such corrected Information Disclosure Statement will help clarify any issues previously raised by the Examiner and aid in the prosecution of the present patent application.

D.   Response to Rejections under 35 U.S.C. § 112

1.   Specification Support of Claims 3-34

The Office Action rejects claims 3-34 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Office Action specified language of claims 3-34 as not being supported by the specification as originally filed.

The following tables list Applicants' claim language in the left column which corresponds to the specification support in the right column.

a.   Claim 3

controlling said computer based on said one or more control signals,	For example, page 485, lines 13-18, page 490, line 35 through page 491, line 6.
generating a receiver specific value by processing information that is stored in said computer	For example, page 486, lines 9-17.
generating a receiver specific signal based on said receiver specific computer generated value	For example, page 491, lines 10-13
Communicating a unit of programming to said output device based on said generated receiver specific signal	For example, page 491, lines 10-16, including "image information" with "$1,071.32" at line 12.
delivering said receiver specific program at said one or more output devices, said receiver specific program including a simultaneous or sequential presentation of two or more of units of programming, said two or more units of programming including said communicated unit of programming and at least one of said received and selected one or more units of programming	For example, page 478, line 26 through page 509, line 32. For example, page 490, lines 11-23

For example, page 491, lines 13-16. For example, page 491, lines 33-35, page 492, line 30 and page 493, line 21.

For example, page 491, line 12 with 13

For example, page 491, lines 15-16 with page 490 lines 21-23. |

b.　　Claim 4

Communicating said generated receiver specific signal to a selective transmission device	For example, page 553, line 33 through page 554 line 1. (with respect to page 554, lines 10-11 and page 551, lines 15-18).
controlling said selective transmission device to select said received one or more units of programming	For example, page 553, line 34 through page 554, line 3.

c.　　Claim 5

said generated receiver specific signal is a programming signal,	For example, page 491, lines 10-13.
placing one or more data for output at a memory location that outputs to said output device	For example, page 486, lines 23-27.

d.　　Claim 6

As a general matter, please see page 514 lines 8-31.

receiving a first control signal at one or more origination transmitters	For example, page 382, lines 2-5.
receiving a second control signal at said one or more origination transmitters, said second control signal operative to communicate said first control signal to an intermediate transmitter	For example, page 385, lines 9-13. For example, page 385, line 11, page 385, line 35 through page 386, line 3; For example, page 386, lines 7-14 and page 325, lines 1-4.
said first control signal effective at said at least one of a plurality of receiver stations to control said computer to compute a receiver specific value by processing information stored in said computer, generate a receiver specific signal based on said receiver specific value, and communicate a unit of programming to said output device based on said receiver specific signal	For example, page 484, lines 12-18 and page 485, lines 14-18. For example, page 486, lines 9-17. For example, page 491, lines 10-13. For example, page 491, lines 10-16, including "image information" with '$1,071.32' at line 12.

e. **Claim 7**

receiving and storing a control signal at a transmitter station	For example, page 382, lines 2-5
said control signal effective at said at least one of a plurality of receiver stations to control said computer to compute a receiver specific value by processing information stored in said computer, generate a receiver specific signal based on said receiver specific value	For example, page 484, lines 12-18 and page 485, lines 14-18. For example, page 486, lines 9-17. For example, page 491, lines 10-13.
communicate a unit of programming to said output device based on said receiver specific signal.	For example, page 491, lines 10-16, including "image information" with '$1,071.32' at line 12.

f. **Claim 8**

one or more units of programming comprise some of a software module,.	For example, page 358, lines 1-21 (see also page 357, lines 21-35); page 16, line 22 and page 364 line 33.
and said one or more control signals operate to generate at least some of the balance of said software module, said method further comprising the step of	For example, page 363, line 34 through page 364, line 1 and page 364 lines 28-31.
incorporating said generated receiver specific value into code	For example, page 323, lines 26-33 and page 364, lines 6-22.

g. **Claim 9**

unit of programming includes the balance of said at least one complete image	For example, Fig. 1A with respect to Fig. 1C.
synchronizing the delivery at or communication from said output device of said delivered two or more units of programming based on information contained in said one or more control signals	For example, page 26, lines 20-28 and page 491, lines 9-13 With, for example, page 486, lines 9-15 and page 379, lines 10-28.
producing said balance of said at	For example, page 486, lines 25-27 with page 491, lines

least one complete image at a specific image location	13-16.

h. Claim 10

assembling at least some portion of said one or more control signals	For example, page 37, lines 22-25 with page 14, lines 24-25 and page 24, lines 15-21.
compiling code to be communicated in said generated receiver specific signal	For example, page 379, lines 19-24 with page 385, lines 9-13 (and page 382, lines 1-5).
linking a unit of programming to be communicated to one of said computer and said output device	For example, page 379, lines 20-21 For example, page 379, line 26. For example, page 386, lines 11-12 and page 325, lines 1-4.
processing machine language code containing said generated receiver specific value	For example, page 54, lines 2-6. For example, page 379, lines 8-10 with page 363, lines 34-35.

i. Claim 12

communicating said receiver specific value from said memory to one of the group consisting of: (1) a video monitor	For example, page 491, lines 10-16.
(2) a speaker	For example, page 492, lines 23-30.
(3) a printer	For example, page 496, lines 3-6.
(4) a processor	For example, page 385, lines 24 and 29-30.
(5) a signal generator	For example, page 385, lines 10-13 or page 386, lines 7-12 with page 385, line 24 and 29-30.
(6) a transmitter	For example, page 386, lines 11-12 with page 325, lines 1-4 and page 385, line 24 with lines 29-30.

j. Claim 13

transferring at least some of said received and selected one or more units of programming to said output device before generating said receiver specific value	For example, page 479, lines 14-32 For example, page 479, line 18; page 485, lines 14-18.

k. Claim 14

generating said receiver specific	For example, page 358, lines 26-29 and page 355 lines 19-

value based on a schedule	26.
selecting at least a portion of said received broadcast or cablecast information transmission in response to said generated receiver specific signal	For example, page 372, lines 1-6.

l.   **Claim 15**

controlling said portion receiver to be capable of receiving and transferring expanded or contracted code portion information transmissions	For example, page 460, lines 12-19 or page 462, lines 6-12 with page 35, lines 7-10.

m.   **Claim 16**

clearing a specific memory location in response to said one or more control signals	For example, page 501, lines 13-17.

n.   **Claim 17**

loading said computer program into the memory of said computer in response to said one or more control signals	For example, page 484, lines 7-18. For example, page 40, lines 16-25 and page 59, lines 29-31.
fetching a software module from a memory peripheral in response to said one or more control signals	For example, page 548, lines 28-30 and page 534, lines 13-20 with page 548, lines 24-25 and lines 1-6.

o.   **Claim 18**

interrupting said controller to cause said computer to communicate said communicated unit of programming at a specific time;	For example, page 175, lines 15-29 with page 484, lines 16-8 and page 485, lines 16-17.
programming said controller to interrupt a specific one of a plurality of processor and/or controller devices	For example, page 91, lines 21-24 with page 202, lines 6-11.

detecting a interrupt signal in the information transmission and controlling said controller to communicate said detected interrupt signal to a processor or controller	For example, page 452, lines 14-20 with page 499, line 32 and page 500, lines 13-15.

p.   Claim 19

detecting a control program in the information transmission and causing said controller to control one or more receiver station devices in accordance with said control program	For example, page 282, line 22 through page 283, line 2. For example, page 283, lines 20-33.

q.   Claim 20

storing information confirming a passing of said identified first control signal;	For example, page 106, lines 24-31 with lines 31-34 and page 101, lines 24-34
effecting a comparison between said stored information and an identifier so as to generate a control signal	For example, page 122, line 34 through page 123, line 15. For example, page 125, lines 14-17.

r.   Claim 21

generating some portion of one of a computer program and a data module in response to an instruct signal	For example, page 363, line 34 through page 364, line 1; page 24, lines 14-21; page 41, lines 20-21; page 365, lines 22-24; and page 359, line 20 through page 360, line 1.

s.   Claim 22

communicating said at least one of said two or more units of programming to said one of said one or more origination transmitters and said intermediate transmitter	For example, page 344, lines 5-7 and page 347, lines 4-5 with Page 367, lines 25-37 and page 372, lines 1-6

t.   **Claim 25**

each of said one or more first control signals received from outside of said intermediate transmitter station	For example, page 23, line 35 through page 24, line 21 with page 20, lines 26-29; page 542, lines 22-26 with page 537, lines 29-32.
each of said second control signals received from outside of said intermediate transmitter station, wherein said one or more second control signals are operative to cause said first computer in said intermediate transmitter station to select a specific first control signal and to communicate said selected first control signal to at least one of said transmitters	For example, page 537, lines 6-17 and page 538, lines 3-12. For example, page 343, line 27; page 420, line 21 through page 421, line 22. For example, page 343, lines 30-32 with page 542, lines 22-26 and page 537, lines 29-32.
said selected first control signal operative at said receiver station to control a second computer to generate a receiver specific value by processing information stored in said second computer, generate a receiver specific signal based on said receiver specific value, and communicate a unit of programming to an output device based on said receiver specific signal	For example, page 548, lines 1-6 with page 552, line 20. For example, page 484, lines 12-18 and page 485, lines 14-18. For example, page 486, lines 9-17. For example, page 491, lines 10-13. For example, page 491, lines 10-16, including "image information" with '$1,071.32' at line 12.

u.   **Claim 26**

said one or more first control signals is received at said intermediate transmitter station before each of said one or more second control signals is received	For example, page 537, lines 6-17. For example, page 342, lines 3-11 and 18-22.

v.   **Claim 27**

one or more first control signals is received at said intermediate transmitter station after one or more of said second control	For example, page 23, line 35 through page 24, line 1. For example, page 342, lines 3-11 and 18-22.

signals is received	

w.   Claim 30

storing said one or more received first control signals in one or more of said storage devices	For example, page 347, lines 2-3 with page 367, lines 32-33. For example, page 554, lines 31-32.
one or more first control signals operative at said receiver station to control a second computer to generate a receiver specific value by processing information stored in said second computer, generate a receiver specific signal based on said receiver specific value, and communicate a unit of programming to an output device based on said receiver specific signal	For example, page 484, lines 12-18 and page 485, lines 14-18. For example, page 486, lines 9-17. For example, page 491, lines 10-13. For example, page 491, lines 10-16, including "image information" with '$1,071.32' at line 12.

x.   Claim 31

of receiving one or more second control signals, wherein said selecting step is performed by said computer based on information contained within said one or more second control signals	For example, page 342, lines 2-11 and 26-31. For example, page 346, line 34 through page 347, line 5.

y.   Claim 32

transmitting step is performed based on information contained within said one or more second control signals	For example, page 366, line 19 through page 367, line 33.

z.   Claim 33

said operating instructions effective to control a processor to respond to one of said first control signal and said second control	For example, page 537, lines 6-17; page 537, line 14; page 548, lines 1-6. For example, page 385, lines 5-6 with page 547, lines 15-

signal	26.

aa. Claim 34

said operating instructions effective to control a processor to respond to said control signal	For example, page 537, lines 6-17; page 537, line 14; page 548, lines 1-6.

2. Further Rejection Under 35 U.S.C. §112, First Paragraph

Claims 3-34 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The Office Action states "[r]egarding claims 6, 7, 21, 22, 33, and 34, although the specification discloses the computation of values of subscriber's portfolio, the specification does not specifically teach that the computation of a receiver specific signal is based on a computed receiver specific value which is computed by processing information stored in a computer. The specification also fails to teach that the output of a unit of programming to an output device is based on the computed specific signal."

The Office Action further states that "although the specification discloses the generation of graphic for representing the performance of the subscriber's stock portfolio, the specification does not specifically teach that the generation of a receiver specific signal is based on a generated value which is computed by processing information stored in a computer. The specification also fails to teach that the output of a unit of programming to an output device is based on the generated specific signal."

Applicants respectfully contend that the specification support provided above, clearly enables one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

3.   Rejections Under 35 U.S.C. §112, Second Paragraph

Claim 21 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. The Office Action states that "Claim 21 is vague and indefinite because it is unclear whether the computer is located in the receiver station or the intermediate transmitter. Claim 21 requires that the computer is connected to the intermediate transmitter while claim 6 requires that the computer is located in the receiver station. Therefore, depend [*sic*] claim 21 is inconsistent with the independent claim 6."

Applicants contend that there is no limitation requiring the intermediate transmitter be located remotely from the receiver station. As such, the computer may be connected to the intermediate transmitter. For at least that reason, Applicants assert that dependent claim 21 is not vague and indefinite, nor is it inconsistent with independent claim 6.

4.   Conclusion

Applicants respectfully submit that claims 3-5, 8-17, 19-20, 22-24, 26-29, 31-33 and amended claims 6, 7, 18, 21, 25, 30, and 34 of the subject application particularly point out and claim the subject matter sufficiently for one of ordinary skill in the art to comprehend the bounds of the claimed invention. The test for definiteness of a claim is whether one skilled in the art would understand the bounds of the patent claim when read in light of the specification, and if the claims so read reasonably apprise those skilled in the art of the scope of the invention, no more is required. *Credle v. Bond*, 25 F.3d 1556, 30 USPQ2d 1911 (Fed. Cir. 1994). The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994). Applicants have amended the claims to enhance clarity and respectfully submit that all pending claims are fully enabled by the specification and distinctly indicate the metes and bounds of the claimed subject matter.

Applicants believe that the above recited changes are sufficient to overcome the rejections under 35 U.S.C. 112, first and second paragraph, and respectfully request withdrawal

of these rejections. Applicants provide these specific embodiments in support of the pending claims by way of example only. The claims must be read as broadly as is reasonable in light of the specification, and Applicants in no way intend that their submission of excerpts/examples be construed to unnecessarily restrict the scope of the claimed subject matter.

E.   Response to Rejection of Claims for Absence of Novelty

1.   35 U.S.C. § 102 (b) Rejection over Metz et al., U.S. Patent No. 3,648,270.

Claim 6 is rejected under 35 U.S.C. § 102 (b) as being anticipated by Metz et al., U.S. Patent No. 3,648,270.

With respect to Applicants' claim 6, the reference fails to teach, *inter alia,* the Applicants' claim limitation of <u>A method of delivering a receiver specific program at at least one</u> <u>of a plurality of receiver stations, each of said plurality of receiver stations having a computer</u> <u>and an output device</u>. There is no concept of any receiver specific program whatsoever in Metz et al. Metz et al. merely discloses the reporting of stock prices on a display screen. There is nothing to suggest that there is any receiver specific data being delivered. Further, there is no suggestion in Metz et al. of a <u>plurality of receiver stations having a computer and an output</u> <u>device</u>. There is no suggestion in Metz et al. that there is any sort of computer at the receiver station. At most, the receiver station in Metz et al. is the Cathode Ray Tube itself and there is no computer in the CRT. The only computer disclosed in Metz et al. is at the transmitter station for inputting values that eventually are displayed on the CRT.

Metz et al. fails to teach, *inter alia*, the Applicants' claim limitation of <u>receiving a first</u> <u>control signal at one or more origination transmitters</u>. There is no control signal disclosed in Metz et al. The Office Action suggests that "the stock ID can be considered as effective to control the computer (Figs. 4-6) to perform computations…and can be considered as "control signal"". Applicants contend that the input of numbers into a computer which subsequently adds or subtracts is not analogous to Applicants' claimed control signal. There is no signal in Metz et al. which can be considered to be a control signal as presently claimed.

Metz et al. fails to teach, *inter alia*, the Applicants' claim limitation of <u>receiving a second</u> <u>control signal at said one or more origination transmitters, said second control signal operative to</u> <u>communicate said first control signal to an intermediate transmitter</u>. As noted above, Applicants contend that there is no control signal taught in Metz et al. As such, there is certainly not a second control signal which <u>operative to communicate said first control signal to an intermediate</u> <u>transmitter</u>.

Metz et al. fails to teach, *inter alia*, the Applicants' claim limitation of <u>transmitting said</u> <u>first control signal to said at least one of said plurality of receiver stations, said first control</u> <u>signal effective at said at least one of a plurality of receiver stations to control said computer to</u> <u>compute a receiver specific value by processing information stored in said computer, generate a</u> <u>receiver specific signal based on said receiver specific value, and communicate a unit of</u> <u>programming to said output device based on said receiver specific signal</u>. There is no concept in Metz et al. of the transmission of a control signal to a receiver station as noted above. Assuming, *arguendo*, that there was a control signal transmitted to the receiver station there is no computer at the receiver station to compute any value. The computer in Metz et al. is located at the transmitter station. Further, any value that is computed by the computer is not receiver specific. There is certainly no communication of <u>a unit of programming to said output device based on</u> <u>said receiver specific signal</u>. There is no receiver specific signal taught in Metz et al. in any event. There is certainly no generation of a receiver specific signal.

Applicants respectfully submit that the cited art does not anticipate claim 6 since the reference fails to disclose every element of the claimed invention, and Applicants respectfully request that the 35 U.S.C. § 102 (b) rejection of claim 6 be withdrawn.

2.   Conclusion

Applicants further respectfully submit that claim 6 in the present application should be allowed because these methods are not disclosed, taught, suggested, or implied by the applied prior art. For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15

USPQ2d 1566 (Fed. Cir. 1990). There must be no difference between the claimed invention and

the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.

Scripps Clinic & Research Foundation v. Genetech, Inc., 927 F.2d 1565, 18 USPQ2d 1001, 18

USPQ2d 1896 (Fed. Cir. 1991). Absence from a cited reference of any element of a claim

negates anticipation of that claim by the reference. *Kloster Speedsteel AB v Crucible, Inc.*, 230

USPQ 81 (Fed. Cir. 1986), *on rehearing*, 231 USPQ 160 (Fed. Cir. 1986).

F.   Response to Obviousness Rejection of Claims

To establish a *prima facie* case of obviousness, three basic criteria must be met. First,

there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art to modify the reference to

combine the teachings. Second, there must be a reasonable expectation of success. Finally, the

prior art reference (or references combined) must teach or suggest all the claim recitations. The

teaching or suggestion to make the claimed combination and the reasonable expectation of

success must both be found in the prior art, not based on Applicants' disclosure. *In re Vaeck*,

947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 706.02(j).

1.   35 U.S.C. § 103 (a) Rejection over Epstein, U.S. Patent No. 3,387,268 in view of Linstroth et al., U.S. Patent No. 4,942,616 or Toy, U.S. Patent No. 4,554,418.

Claims 6, 7 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Epstein, U.S. Patent No. 3,387,268 in view of Linstroth et al., U.S. Patent No. 4,942,616 or Toy,

U.S. Patent No. 4,554,418.

a.   Independent Claim 6

With respect to Applicants' claim , Epstein in view of Linstroth or Toy fails to, *inter alia*,

teach or suggest all the claim recitations, i.e., <u>A method of delivering a receiver specific program</u>

<u>at at least one of a plurality of receiver stations, each of said plurality of receiver stations having</u>

<u>a computer and an output device</u>. Epstein does not disclose a method for delivering a program.

There is certainly no suggestion of a delivering a receiver specific program. Epstein discloses the

delivery of stock quotes to a receiver, wherein the receiver is set up (e.g. using toggle switches) to display only some of the received information. The stock information that is transmitted is the same for all receivers and is, therefore, not receiver specific.

Epstein fails to teach, either alone or in combination, the Applicants' claim limitation of receiving a first control signal at one or more origination transmitters. There is no suggestion of any control signal in Epstein. The Office Action states that "the stock symbol can be considered as 'effective to control the computer (Figs. 4-6) to perform computations'...and can be considered as [a] "control signal"". Applicants contend that the incoming stock symbol is not analogous to Applicants' claimed control signal. The incoming stock symbol is simply compared to the stock symbol in the receiver to determine if the related stock information should be stored or discarded. There is no suggestion that the stock symbol acts as a control signal.

Epstein fails to teach, either alone or in combination, the Applicants' claim limitation of receiving a second control signal at said one or more origination transmitters, said second control signal operative to communicate said first control signal to an intermediate transmitter. There is no teaching of any control signal in Epstein as noted above. There is certainly not a second control signal operative to communicate said first control signal to an intermediate transmitter. There is no such signal in Epstein whatsoever. Furthermore, since there is no first control signal taught in Epstein, there certainly can't be a second control signal that is operative to transmit that first control signal. Assuming, *arguendo*, that Epstein did teach a first control signal as suggested by the Office Action, there is no signal which acts to transmit that control signal to an intermediate transmitter.

Epstein fails to teach, either alone or in combination, the Applicants' claim limitation of transmitting said first control signal to said at least one of said plurality of receiver stations, said first control signal effective at said at least one of a plurality of receiver stations to control said computer to compute a receiver specific value by processing information stored in said computer, generate a receiver specific signal based on said receiver specific value, and communicate a unit of programming to said output device based on said receiver specific signal. There is no

suggestion in Epstein of transmitting a control signal to a receiver station. As indicated above, there is no such control signal taught in Epstein. There is certainly no signal in Epstein which controls the computer at the receiver station to compute a receiver specific value by processing information stored in the computer. No such calculation of a receiver specific value takes place. Although there is a receiver specific signal taught in Epstein (i.e. signal outputted to flashing lights 85) such a signal is not generated based on a receiver specific value. There is no teaching of a receiver specific value in Epstein. Assuming, *arguendo*, that there is a receiver specific value in Epstein, the receiver specific signal is not based on such a value. The receiver specific signal in Epstein is merely an indicator of market activity, not of a particular calculated value.

Applicants submit that there is no motivation to combine Epstein with either Linstroth et al. or Toy. Epstein is silent as to transmission of voice messages as in either Linstroth et al. or Toy. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re Laskowski, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989).

Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claim 6 be withdrawn.

b.   Independent Claim 7

With respect to Applicants' claim 7, Epstein in view of Linstroth or Toy fails to, *inter alia*, teach or suggest all the claim recitations, i.e., <u>A method of delivering a receiver specific program at at least one of a plurality of receiver stations, each of said plurality of receiver stations having a computer and an output device</u>. Epstein does not disclose a method for delivering a program. There is certainly no suggestion of a delivering a receiver specific program. Epstein discloses the delivery of stock quotes to a receiver, wherein the receiver is set up (e.g. using toggle switches) to display only some of the received information. The stock information that is transmitted is the same for all receivers and is, therefore, not receiver specific.

Epstein fails to teach, either alone or in combination, the Applicants' claim limitation of <u>receiving and storing a control signal at a transmitter station</u>. There is no suggestion of any

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control signal in Epstein. The Office Action states that "the stock symbol can be considered as 'effective to control the computer (Figs. 4-6) to perform computations'…and can be considered as [a] "control signal"". Applicants contend that the incoming stock symbol is not analogous to Applicants' claimed control signal. The incoming stock symbol is simply compared to the stock symbol in the receiver to determine if the related stock information should be stored or discarded. There is no suggestion that the stock symbol acts as a control signal.

Epstein fails to teach, either alone or in combination, *inter alia*, the Applicants' claim limitation of <u>causing said control signal to be communicated to a transmitter at a specific time, thereby to transmit said control signal, said control signal effective at said at least one of a plurality of receiver stations to control said computer to compute a receiver specific value by processing information stored in said computer, generate a receiver specific signal based on said receiver specific value, and communicate a unit of programming to said output device based on said receiver specific signal</u>. There is no suggestion in the specification nor in the Office Action of transmitting a control signal at a specific time. As indicated above, there is no such control signal taught in Epstein. There is certainly no signal in Epstein which controls the computer at the receiver station to compute a receiver specific value by processing information stored in the computer. No such calculation of a receiver specific value takes place. Although there is a receiver specific signal taught in Epstein (i.e. signal outputted to flashing lights 85) such a signal is not generated based on a receiver specific value. There is no teaching of a receiver specific value in Epstein. Assuming, *arguendo*, that there is a receiver specific value in Epstein, the receiver specific signal is not based on such a value. The receiver specific signal in Epstein is merely an indicator of market activity, not of a particular calculated value.

The Office Action suggests that "it would have been obvious to an artisan of ordinary skill at the time of the invention to apply the teaching of Linstroth et al. or Toy to the system of Epstein…".

Applicants submit that there is no motivation to combine Epstein with either Linstroth et al. or Toy. Epstein is silent as to transmission of voice messages as in either Linstroth et al. or

Toy. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re Laskowski, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989).

Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claim 7 be withdrawn.

c.   Dependent Claim 22

Claim 22 depends upon independent claim 6. As discussed *supra,* Epstein in view of Linstroth et al. or Toy fails to disclose every element of claim 6 and thus, *ipso facto,* Epstein in view of Linstroth et al. or Toy fails to anticipate dependent claim 22, and therefore, this rejection should be withdrawn and the claim be permitted to issue. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine,* 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

> **2.   35 U.S.C. § 103 (a) Rejection over Epstein, U.S. Patent No. 3,387,268 in view of Linstroth et al., U.S. Patent No. 4,942,616 or Toy, U.S. Patent No. 4,554,418, further in view of Fletcher et al., U.S. Patent No. 4,054,911.**

Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epstein, U.S. Patent No. 3,387,268 in view of Linstroth et al., U.S. Patent No. 4,942,616 or Toy, U.S. Patent No. 4,554,418 further in view of Fletcher et al., U.S. Patent No. 4,054,911.

Claim 33 depends upon independent claim 6. Claim 34 depends upon independent claim 7. As discussed *supra,* Epstein in view of Linstroth et al. or Toy fails to disclose every element of claims 6 and 7 and thus, *ipso facto,* Epstein in view of Linstroth et al. or Toy, further in view of Fletcher et al. fails to anticipate dependent claims 33 and 34, and therefore, this rejection should be withdrawn and the claims be permitted to issue. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine,* 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

3.   **35 U.S.C. § 103 (a) Rejection over Foss, U.S. Patent No. 1,927,702 in view of Fletcher et al., U.S. Patent No. 4,054,911.**

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foss, U.S. Patent No. 1,927,702 in view of Fletcher et al., U.S. Pat. No. 4,054,911.

a.   Independent Claim 6

With respect to Applicants' claim 6, Foss in view of Fletcher et al. fails to, *inter alia*, teach or suggest all the claim recitations, i.e., <u>A method of delivering a receiver specific program at at least one of a plurality of receiver stations, each of said plurality of receiver stations having a computer and an output device</u>. Foss does not teach delivering a receiver specific program. The information transmitted in Foss is simply average stock prices that are displayed on a master board. The data would be the same regardless of where it was transmitted and there is no suggestion that is specific to the master display board.

Foss, either alone or in combination, fails to teach, *inter alia*, the Applicants' claim limitation of <u>receiving a second control signal at said one or more origination transmitters, said second control signal operative to communicate said first control signal to an intermediate transmitter</u>. There is no suggestion of a second control signal which is operative to communicate a first control signal. There is certainly no suggestion of transmitting a control signal to an intermediate transmitter. The Office Action provides no support for such a conclusion.

Foss, either alone or in combination, fails to teach, *inter alia*, the Applicants' claim limitation of <u>transmitting said first control signal to said at least one of said plurality of receiver stations, said first control signal effective at said at least one of a plurality of receiver stations to control said computer to compute a receiver specific value by processing information stored in said computer, generate a receiver specific signal based on said receiver specific value, and communicate a unit of programming to said output device based on said receiver specific signal</u>. There is no suggestion in Foss that the control signal is transmitted to the receiver station. The signals which control the computer to compute the average stock price are certainly not

transmitted to the receiver station. The computer most closely relates to the Applicants' transmitter station, while the display board most closely relates to the Applicants' receiver station. The signals controlling the computer are therefore acting at the transmitter station. There is certainly no suggestion in Foss of computing a receiver specific value. As noted above, there is no receiver specific value disclosed in Foss. There is certainly no computation of receiver a specific value by processing information stored in the computer. There is no concept of computing a receiver specific signal in Foss. As noted above, the stock information transmitted to the display board is not receiver specific.

Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claim 6 be withdrawn.

b. Independent Claim 7

With respect to Applicants' claim 7, Foss in view of Fletcher et al. fails to, *inter alia*, teach or suggest all the claim recitations, i.e., <u>A method of delivering a receiver specific program</u> <u>at at least one of a plurality of receiver stations, each of said plurality of receiver stations having</u> <u>a computer and an output device.</u> Foss does not teach delivering a receiver specific program. The information transmitted in Foss is simply average stock prices that are displayed on a master board. The data would be the same regardless of where it was transmitted and there is no suggestion that is specific to the master display board.

Foss, either alone or in combination, fails to teach, *inter alia*, the Applicants' claim limitation of <u>causing said control signal to be communicated to a transmitter at a specific time,</u> <u>thereby to transmit said control signal, said control signal effective at said at least one of a</u> <u>plurality of receiver stations to control said computer to compute a receiver specific value by</u> <u>processing information stored in said computer, generate a receiver specific signal based on said</u> <u>receiver specific value, and communicate a unit of programming to said output device based on</u> <u>said receiver specific signal.</u> There is no suggestion in Foss that a control signal is communicated at a specific time. There is certainly no suggestion that the control signal is effective to control the computer to compute a receiver specific value. There is no receiver

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specific value disclosed in Foss whatsoever. The Office Action equates Applicants' control signal with the signal which is transmitted to cause the computer (as a receiver station) to compute the average price of a stock. The Office Action also equates the computer with the Applicants' transmitter station. Applicants assert that it is improper to analogize one element of the reference with multiple limitations of the Applicants' claim in this manner. For at least this reason, Applicants' contend the claim is allowable.

Furthermore, Foss fails to disclose the Applicants' claim limitation of <u>generate a receiver specific signal based on said receiver specific value, and communicate a unit of programming to said output device based on said receiver specific signal</u>. There is no suggestion of a receiver specific signal as noted above. There is certainly no concept of communicating a unit of programming to an output device based on such a signal.

Foss, either alone or in combination, fails to teach, *inter alia*, the Applicants' claim limitation of <u>receiving and storing a control signal at a transmitter station</u>. Foss does not disclose the storage of any signal at the transmitter station. The Office Action suggests that "[a]lthough Foss does not specifically disclose that the signals ("control signal") is [*sic*] stored in the transmitter, Fletcher et al. in col. 5, lines 46-52 clearly disclose that the control signals can be stored in the data base of the transmitter station."

Applicants respectfully submit that there is no motivation to combine Foss with Fletcher et al. Foss deals with an analog computer performing calculations, the results of which are output on a local display board. There is no suggestion to combine such an invention with the teachings of Fletcher et al. which deals with a sophisticated broadcasting system. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re Laskowski, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989).

Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claim 7 be withdrawn.

4.   35 U.S.C. § 103 (a) Rejection over "TELESOFTWARE-
      VALUE ADDED TELETEXT" by J. Hedger et al. in
      view of Cox et al., U.S. Patent No. 4,388,645.

Claims 25-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hedger in

view of Cox et al. U.S. Patent No. 4,388,645.

a.   Independent Claim 25

With respect to Applicants' claim 30, Hedger in view of Cox et al. fails to, *inter alia*,

teach or suggest all the claim recitations, i.e., A method for controlling the transmission of a

control signal from an intermediate transmitter station to a receiver station, said intermediate

transmitter station having a first computer, one or more receivers and one or more transmitters.

Hedger does not teach an intermediate transmitter station as presently claimed. Therefore, there

can be no teaching of the Applicants' claimed elements at such an intermediate transmitter

station.

Hedger, either alone or in combination, fails to teach, *inter alia*, the Applicants' claim

limitation of receiving, at one or more of said receivers of said intermediate transmitter station,

one or more first control signals, each of said one or more first control signals received from

outside of said intermediate transmitter station. The Office Action suggests that the program in

the downloaded telesoftware is analogous to Applicants' claimed first control signal. Applicants

contend that the program in Hedger is not analogous to the claimed control signal. The program

is merely downloaded at the computer at the receiver station and performs no controlling

function whatsoever. In Hedger, the viewer executes the program, thereby serving as the only

control.

Hedger, either alone or in combination, fails to teach, *inter alia*, the Applicants' claim

limitation of receiving, at one or more of said receivers of said intermediate transmitter station,

one or more second control signals, each of said second control signals received from outside of

said intermediate transmitter station, wherein said one or more second control signals are

operative to cause said first computer in said intermediate transmitter station to select a specific

first control signal and to communicate said selected first control signal to at least one of said transmitters of said intermediate transmitter station. There is no suggestion in Hedger of a second control signal. There is certainly no suggestion of any signal that is operative to cause said first computer in said intermediate transmitter station to select a specific first control signal. There is no selection of any control signal whatsoever in Hedger. It follows that there can be no teaching of communicating said selected first control signal to at least one of said transmitters of said intermediate transmitter station. As noted above, there is no intermediate transmitter station taught in Hedger in any event.

The Office Action suggests that "Hedger differs from claims 25 and 30 in that Hedger does not show an intermediate transmitter station. However, as evidenced by Figs. 1 and 4 of Cox et al., providing an intermediate transmitter station for receiving, storing and rebroadcasting the teletext programming is known." Applicants contend that although Cox et al. discloses an intermediate transmitter station, there is no teaching of a second control signal as suggested by the Office Action. The Office Action suggests that the time codes of Cox et al. are analogous to the Applicants' second control signal. Cox et al. teaches that row 24 and 25 are simply compared by the decoder in order to enabled each page memory for a short interval if the time on and time off codes stored in row address 24 of the memory correspond to the current time of day code. There is simply no mention of the time codes being operative to cause said first computer in said intermediate transmitter station to select a specific first control signal and to communicate said selected first control signal to at least one of said transmitters of said intermediate transmitter station. In fact, Cox et al. teaches that if the codes correspond, the pages will be sequentially read from sequence continuously and repeatedly as long as the codes correspond. (See Cox et al., col. 6 lines 24-33).

Hedger, either alone or in combination, fails to teach, inter alia, the Applicants' claim limitation of transmitting, from said one or more transmitters of said intermediate transmitter station to said receiver station, said selected first control signal, said selected first control signal operative at said receiver station to control a second computer to generate a receiver specific

value by processing information stored in said second computer, generate a receiver specific signal based on said receiver specific value, and communicate a unit of programming to an output device based on said receiver specific signal. As noted above, there is no teaching of an intermediate transmitter station in Hedger. There is certainly not a selected first control signal as noted above. Assuming, *arguendo*, there is a control signal taught in Hedger, there is certainly no control signal which is operative at said receiver station to control a second computer to generate a receiver specific value by processing information stored in said second computer. There is no suggestion of a second computer in Hedger or in Cox et al. Furthermore, there is no suggestion that any receiver specific value is generated. The word 'generating', as defined by Webster's New Riverside University Dictionary, means "To bring into existence, to produce". Mere movement of something (i.e. a signal) from one place to another does not constitute generation. Certainly, since there is no second computer disclosed in Hedger, there can be no information stored in such a computer. It follows that there can be no generation of a receiver specific signal. Certainly there can be no generation of a receiver specific signal based on said receiver specific value. Finally, there is no suggestion in Hedger of communicating a unit of programming to an output device based on said receiver specific signal. There is no suggestion of communicating a unit of programming. There is certainly no suggestion that such communication is based on said receiver specific signal, because such a signal is not disclosed.

Applicants submit that there is no motivation to combine Hedger with Cox et al. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re Laskowski, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989).

Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claim 25 be withdrawn.

b.   Independent Claim 30

With respect to Applicants' claim 30, Hedger in view of Cox et al. fails to, *inter alia*, teach or suggest all the claim recitations, i.e., A method for controlling the transmission of a

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control signal from an intermediate transmitter station to a receiver station, said intermediate transmitter station having a computer, one or more storage devices, one or more receivers and one or more transmitters. Hedger does not teach an intermediate transmitter station as presently claimed. Therefore, there can be no teaching of the Applicants' claimed elements at such an intermediate transmitter station.

Hedger, either alone or in combination, fails to teach, *inter alia*, the Applicants' claim limitation of receiving, at one or more of said receivers of said intermediate transmitter station, one or more first control signals, each of said first control signals received from outside of said intermediate transmitter station. The Office Action suggests that the program in the downloaded telesoftware is analogous to Applicants' claimed first control signal. Applicants contend that the program in Hedger is not analogous to the claimed control signal. The program is merely downloaded at the computer at the receiver station and performs no controlling function whatsoever and certainly does not perform as Applicants' first control signal does.

The Office Action fails to address the Applicants' claim limitation of storing said one or more received first control signals in one or more of said storage devices. Applicants contend that Hedger, either alone or in combination, fails to teach this limitation for at least the reason that Hedger fails to teach a first control signal as noted above.

Hedger, either alone or in combination, fails to teach, *inter alia*, the Applicants' claim limitation of selecting one or more of said received first control signals to be communicated to one or more of said transmitters of said intermediate transmitter station. There is no suggestion of selecting a first control signal as claimed. There is no selection of any signal whatsoever. Certainly, since there is no teaching of a control signal, there can be no suggestion of selecting such a signal.

Hedger, either alone or in combination, fails to teach, *inter alia*, the Applicants' claim limitation of transmitting, from said one or more transmitters of said intermediate transmitter station to said receiver station, one or more of said selected one or more first control signals, each of said selected one or more first control signals operative at said receiver station to control a

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second computer to generate a receiver specific value by processing information stored in said

second computer, generate a receiver specific signal based on said receiver specific value, and

communicate a unit of programming to an output device based on said receiver specific signal.

As noted above, there is no teaching of an intermediate transmitter station in Hedger. There is

certainly not a selected first control signal as noted above. Assuming, *arguendo*, there is a

control signal taught in Hedger, there is certainly no control signal which is operative at said

receiver station to control a second computer to generate a receiver specific value by processing

information stored in said second computer. There is no suggestion of a second computer in

Hedger or in Cox et al. Furthermore, there is no suggestion that any receiver specific value is

generated. The word 'generating', as defined by Webster's New Riverside University Dictionary,

means "To bring into existence, to produce". Mere movement of something (i.e. a signal) from

one place to another does not constitute generation. Certainly, since there is no second computer

disclosed in Hedger, there can be no information stored in such a computer. It follows that there

can be no generation of a receiver specific signal. Certainly there can be no generation of a

receiver specific signal based on said receiver specific value. Finally, there is no suggestion in

Hedger of communicating a unit of programming to an output device based on said receiver

specific signal. There is no suggestion of communicating a unit of programming. There is

certainly no suggestion that such communication is based on said receiver specific signal,

because such a signal is not disclosed.

Applicants submit that there is no motivation to combine the teachings of Hedger with

Cox et al. "The mere fact that the prior art could be so modified would not have made the

modification obvious unless the prior art suggested the desirability of the modification." In re

Laskowski, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989).

Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claim 30 be

withdrawn.

c.   **Dependent Claims 26-29 and 31-32**

Claims 26-29 depend upon independent claim 25. Claims 31-32 depend upon

independent claim 30. As discussed *supra,* Hedger in view of Cox et al. fails to disclose every

element of independent claims 25 and 30 and thus, *ipso facto,* Hedger in view of Cox et al. fails

to anticipate dependent claims 26-29 and 31-32, and therefore, this rejection should be

withdrawn and the claims be permitted to issue. If an independent claim is nonobvious under 35

U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine,* 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988).

5.   **35 U.S.C. § 103 (a) Rejection over Fletcher et al., U.S.
Patent No.4,054,911 in view of Linstroth et al., U.S.
Patent No. 4,942,616 or Toy, U.S. Patent No. 4,554,418
further in view of Cox et al., U.S. Patent No. 4,388,645.**

Claims 25-32 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Fletcher

et al., U.S. Patent No.4,054,911 in view of Linstroth et al., U.S. Patent No. 4,942,616 or Toy,

U.S. Patent No. 4,554,418 further in view of Cox et al., U.S. Patent No. 4,388,645.

a.   **Independent Claim 25**

With respect to Applicants' claim 25, Fletcher et al., either alone or in combination fails

to, *inter alia,* teach or suggest all the claim recitations, i.e., A method for controlling the

transmission of a control signal from an intermediate transmitter station to a receiver station, said

intermediate transmitter station having a first computer, one or more receivers and one or more

transmitters. Fletcher et al. fails to teach an intermediate transmitter station. As such, there can

be no teaching of the Applicants' claimed elements (i.e. computer, receivers, transmitters) at such

a station.

Fletcher et al., either alone or in combination, fails to teach, *inter alia,* the Applicants'

claim limitation of receiving, at one or more of said receivers of said intermediate transmitter

station, one or more first control signals, each of said one or more first control signals received

from outside of said intermediate transmitter station. Fletcher et al.'s control program is not

analogous to Applicants' first control signal as suggested by the Office Action as will be

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described herein below. Furthermore, since there is no intermediate transmitter station, there can certainly be no receipt of a control signal at such a station.

Fletcher et al., either alone or in combination fails to teach, *inter alia*, the Applicants' claim limitation of <u>receiving, at one or more of said receivers of said intermediate transmitter station, one or more second control signals, each of said second control signals received from outside of said intermediate transmitter station, wherein said one or more second control signals are operative to cause said first computer in said intermediate transmitter station to select a specific first control signal and to communicate said selected first control signal to at least one of said transmitters of said intermediate transmitter station</u>. There is no suggestion in Fletcher et al. of a second control signal. In fact, there is no signal which functions as Applicants' claimed second control signal and is <u>operative to cause said computer in said intermediate transmitter station to select a specific first control signal and to communicate said selected first control signal to at least one of said transmitters of said intermediate transmitter station</u>. There is certainly no selection of a specific first control signal in any fashion and therefore, no communication of such a specific first control signal to a transmitter. In fact, since there is no intermediate transmitter station taught in Fletcher et al., there can be no receipt of a second control signal at such a station.

The Office Action suggests that "…Fletcher et al. … differs from claims 25 and 30 in that it does not show an intermediate transmitter station. However, as evidenced by Figs. 1 and 4 of Cox et al., providing an intermediate transmitter station for receiving, storing and rebroadcasting the teletext programming is known." Applicants contend that although Cox et al. discloses an intermediate transmitter station, there is certainly no teaching of a second control signal as suggested by the Office Action. The Office Action suggests that the time codes of Cox et al. are analogous to the Applicants' second control signal. Cox et al. teaches that row 24 and 25 are simply compared by the decoder in order to enabled each page memory for a short interval if the time on and time off codes stored in row address 24 of the memory correspond to the current time of day code. There is simply no mention of the time codes being <u>operative to cause said</u>

first computer in said intermediate transmitter station to select a specific first control signal and to communicate said selected first control signal to at least one of said transmitters of said intermediate transmitter station. In fact, Cox et al. teaches that if the codes correspond, the pages will be sequentially read from sequence continuously and repeatedly as long as the codes correspond. (*See* Cox et al., col. 6 lines 24-33).

Fletcher et al., either alone or in combination, fails to teach, *inter alia*, the Applicants' claim limitation of transmitting, from said one or more transmitters of said intermediate transmitter station to said receiver station, said selected first control signal, said selected first control signal operative at said receiver station to control a second computer to generate a receiver specific value by processing information stored in said second computer, generate a receiver specific signal based on said receiver specific value, and communicate a unit of programming to an output device based on said receiver specific signal. As noted above, the Office Action suggests that Fletcher et al.'s control program is analogous to Applicants' first control signal. There is no suggestion that Fletcher et al.'s control program functions as Applicants' first control signal in that it is operative at said receiver station to control a second computer to generate a receiver specific value by processing information stored in said second computer. Assuming, *arguendo*, that Fletcher et al.'s control programs are analogous to Applicants' first control signal, there is certainly no *generation* of a receiver specific value. The word 'generating', as defined by Webster's New Riverside University Dictionary, means "To bring into existence, to produce". Mere movement of something (i.e. a signal) from one place to another does not constitute generation. In fact, there is no receiver specific information whatsoever in Fletcher et al. It follows that there is no teaching of the generation of a receiver specific signal in Fletcher et al. and certainly no generation of a receiver specific signal based on said receiver specific value.

The Office Action suggests that "[a]lthough Fletcher et al. does not specifically disclose communicating a unit of programming based on a receiver specific signal, Linstroth et al. or Toy clearly teaches such.

Applicants submit that there is no motivation to combine the teachings of Fletcher et al. with either Linstroth et al., Toy or Cox et al. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re Laskowski, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989).

Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claim 25 be withdrawn.

b. Independent Claim 30

With respect to Applicants' claim 30, Fletcher et al., either alone or in combination, fails to, *inter alia*, teach or suggest all the claim recitations, i.e., <u>A method for controlling the transmission of a control signal from an intermediate transmitter station to a receiver station, said intermediate transmitter station having a computer, one or more storage devices, one or more receivers and one or more transmitters</u>. Fletcher et al. fails to teach an intermediate transmitter station. As such, there can be no teaching of the Applicants' claimed elements (i.e. computer, receivers, transmitters) at such a station.

Fletcher et al., either alone or in combination, fails to teach, *inter alia*, the Applicants' claim limitation of <u>receiving, at one or more of said receivers of said intermediate transmitter station, one or more first control signals, each of said first control signals received from outside of said intermediate transmitter station</u>. Fletcher et al.'s control program is not analogous to Applicants' first control signal as suggested by the Office Action as will be described herein below. Furthermore, since there is no intermediate transmitter station, there can certainly be no receipt of a control signal at such a station. If follows that since there is no teaching of receiving a first control signal as noted above, there can be no teaching <u>storing said one or more received first control signals in one or more of said storage devices</u>.

Fletcher et al., either alone or in combination, fails to teach, *inter alia*, Applicants' claim limitation of <u>selecting one or more of said received first control signals to be communicated to one or more of said transmitters of said intermediate transmitter station</u>. There is certainly no

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selection of a first control signal in any fashion and therefore, no communication of such a first control signal to a transmitter. In fact, since there is no intermediate transmitter station taught in Fletcher et al., no communication of a first control signal can take place at such a station.

Fletcher et al., either alone or in combination, fails to teach, *inter alia*, Applicants' claim limitation of transmitting, from said one or more transmitters of said intermediate transmitter station to said receiver station, one or more of said selected one or more first control signals, each of said selected one or more first control signals operative at said receiver station to control a second computer to generate a receiver specific value by processing information stored in said second computer, generate a receiver specific signal based on said receiver specific value, and communicate a unit of programming to an output device based on said receiver specific signal. As noted above, the Office Action suggests that Fletcher et al.'s control program is analogous to Applicants' first control signal. There is no suggestion that Fletcher et al.'s control program functions as Applicants' first control signal in that it is operative at said receiver station to control a second computer to generate a receiver specific value by processing information stored in said second computer. Assuming, *arguendo*, that Fletcher et al.'s control programs are analogous to Applicants' first control signal, there is certainly no *generation* of a receiver specific value. The word 'generating', as defined by Webster's New Riverside University Dictionary, means "To bring into existence, to produce". Mere movement of something (i.e. a signal) from one place to another does not constitute generation. In fact, there is no receiver specific information whatsoever in Fletcher et al. It follows that there is no teaching of the generation of a receiver specific signal in Fletcher et al. and certainly no generation of a receiver specific signal based on said receiver specific value.

The Office Action suggests that "[a]lthough Fletcher et al. does not specifically disclose communicating a unit of programming based on a receiver specific signal, Linstroth et al. or Toy clearly teaches such.

Applicants submit that there is no motivation to combine the teachings of Fletcher et al. with either Linstroth et al., Toy or Cox et al. "The mere fact that the prior art could be so

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modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re Laskowski, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989).

Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claim 30 be withdrawn.

c. Dependent Claims 26-29 and 31-32

Claims 26-29 depend upon independent claim 25. Claims 31-32 depend upon independent claim 30. As discussed *supra,* Fletcher et al. in view of Linstroth et al. or Toy, further in view of Cox et al. fails to disclose every element of independent claims 25 and 30 and thus, *ipso facto*, Fletcher et al. in view of Linstroth et al. or Toy, further in view of Cox et al. fails to anticipate dependent claims 26-29 and 31-32, and therefore, this rejection should be withdrawn and the claims be permitted to issue. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).